

REMARKS

This Amendment is in response to the Office Action mailed November 10, 2003. In the Office Action, claims 6-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pauley (U.S. Patent No. 5,900,916) in view of Schein (U.S. Patent No. 5,801,787). Applicant respectfully traverses the rejection and incorporates by reference the remarks set forth in the amendment and response dated May 5, 2003.

According to MPEP §§ 2142 & 2143, a *prima facie* case of obviousness is not established unless three basic criteria are met.

First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (Emphasis added). *See MPEP § 2142.*

In essence, according to MPEP § 2143.03, all claim limitations must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

With respect to Response to Argument (Section 4), the Examiner concurs that neither Pauley nor Schein disclose concurrent or simultaneous display on the monitor in different locations. *See Page 3 of the Office Action dated 11/10/03, hereinafter "outstanding OA".* However, the outstanding OA alleges that the "simultaneous display in differing locations is notoriously well known in the art...[t]herefore, it would have been obvious to one skilled in the art to modify Pauley to include the claimed limitation." *Id.* Applicant respectfully disagrees.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re

Mills, 916 F.2d 16 USPQ2d 1430 (Fed. Cir. 1990).” *See MPEP § 2143.01*. As Examiner explicitly states, neither Pauley nor Schein disclose the claimed limitation.

In fact, Pauley teaches away from the claimed limitation by teaching overlaying of the images for Picture-in-Picture (PIP). For instance, “‘picture-in-picture’ or ‘PIP’ means a main picture with a smaller picture from a second channel *overlaying* the main picture.” *See Col. 5, lines 28-30 of Pauley*. Such contrary teachings are *per se* evidence of a lack of obviousness. Schein does not disclose the concurrent displaying of multiple images or the concurrent servicing of program sources to display multiple images.

Thus, neither Pauley nor Schein disclose or suggest simultaneous display in differing locations. Hence, for the foregoing reasons, Applicant respectfully requests that the §103(a) rejection of independent claims 6, 16, 26, 41, 46, 70 and 73 be withdrawn because each of these claims includes the claimed limitation.

Regarding dependent claims 6, 16-17 and 26-27, the Examiner takes Official Notice that “it is would have been well known in the art to simultaneously display two signals on differing portions of a display screen.” *See Pages 6 & 9 of the outstanding OA*. Moreover, with respect to claims 7-9, 21-23 and 31-33, the Examiner takes Official Notice that “it is notoriously well known in the art to implement amplitude modulation, frequency modulation and phase modulation for transmitting programs from a central station to terminals at user locations.” *See Page 7 of outstanding OA*. Applicant respectfully challenges the taking of each Official Notice set forth in the outstanding OA.

With respect to Sections 1-3 of the Response to Argument, Applicant respectfully disagrees with the Examiner and respectfully reserves the right to argue these differences of opinion if an appeal is warranted.


CONCLUSION

In view of the foregoing it is respectfully submitted that the pending claims are in condition for allowance.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: May 10, 2004

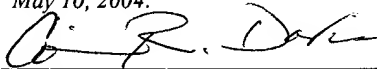


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5/10/04
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